

REMARKS

This communication responds to the *Office Action* June 27, 2012. Although the undersigned believes the previously pending claims distinguished themselves over the cited art, the undersigned has nonetheless amended claims 1, 4, 11, 12, and 14-20 to advance prosecution and not for reasons of patentability. Support for the claim amendments may be found at, for example, page 4, lines 6-8 and page 5, lines 13-15. No claims are canceled or added. Consequently, claims 1-20 remain pending in this application.

Unless otherwise stated herein, amendments to the claims have been made to clarify meaning, correct typographical errors, provide proper antecedent basis, or provide consistent terminology, and not for reasons related to patentability. As indicated, the amendments are fully supported by the Application as-filed. Thus, no new matter has been added.

Formal Request for Telephonic Interview

If the present amendments and remarks do not result in an allowance of all claims, the undersigned formally requests that, before issuance of any further *Office Action*, a telephonic interview be held between the Examiner and the undersigned, Bradley W. Scheer, at the Examiner's convenience. The Examiner is requested to phone Mr. Scheer at (408) 660-2015 to arrange a time for such telephonic interview.

The Rejection of Claims Under 35 U.S.C. § 103(a)

On page 2, paragraph 5 of the *Office Action*, the Examiner rejected claims 1-8, 10-18, and 20 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,553,347 to Tavor *et al.* (Tavor) in view of U.S. Patent No. 6,556,974 to D'Alessandro. The undersigned respectfully traverses the rejection.

The basis for an obviousness rejection is grounded in a consideration of all claim elements. "All words in a claim must be considered in judging the patentability of that claim

against the prior art.”¹ Additionally, to render the claimed subject matter obvious, the prior art references must teach or suggest every feature of the claims.² The undersigned will show that the cited references, either singly or in combination, neither teach nor suggest all limitations of the claims of the Application.

In particular, amended claim 1 recites, *inter alia*,

A method of managing a dispute about *a pre-existing contract*, the method comprising:

automatically receiving, over a network by a system computer, information relating to the dispute, the information being generated from one of an initiator computer associated *with an initiator and a respondent computer associated with a respondent, the initiator and the respondent being parties to the pre-existing contract*; and

iteratively providing portions of the information to the other of the initiator computer and the respondent computer in accordance with predetermined criteria.

The other independent claim of the Application, claim 11, shares with claim 1 limitations similar to at least those shown above.

In contrast to all independent claims of the Application, *Tavor* is completely silent on dispute resolution relating to a dispute about a preexisting contract. Instead, *Tavor* merely discusses pre-contract types of price *negotiations*. Negotiations are steps that may be used in contract formation but they are not a contract. According to *Tavor*, a system and method are discussed in which the method is to conduct negotiations.

[F]or conducting ‘one to one’ commercial negotiations . . . The negotiation process consists of sending persuasive texts to the user by the system, including discounts given by the system and responses to the price offers of the user. The system offers the

¹ *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). See also MPEP § 2143.03.

² See Manual of Patent Examining Procedure §§ 706.02(j), 2143(A) (2008); MPEP § 2142 (2006) (citing *In re Vaeck*, 947 F.2d, 488 (Fed. Cir. 1991)). Cited approvingly in *Ex parte WEN WEN and PATRICIA NG* at 7; Appeal No. 2009-000776; decided September 25, 2009.

product for a specific price, a price that may be optionally decreased as negotiation continues.³

Since *Tavor* discusses only price negotiations prior to a contract ever being formed, *Tavor* fails to discuss, or even hint at, dispute resolution related to non-performance of a preexisting contract.

The Examiner relied exclusively on *D'Alessandro* only to teach or suggest "a method for evaluating current business performance."⁴ Additionally, *D'Alessandro* merely discusses assessments of the performance of a business or other organization. "A system for providing accurate, quantifiable and reproducible assessments of an organization's performance based on predetermined criteria."⁵ In fact, *D'Alessandro* fails to provide any discussion on any type of contract. Thus, *D'Alessandro* fails to remedy the deficiencies of *Tavor* discussed above.

Since the undersigned has shown that not all the claimed elements were known as required by relevant case law and the MPEP, either by *Tavor* singly or in combination with *D'Alessandro*, the undersigned submits that independent claims 1 and 11 are patentable. Further, since claims 2-8, 10, 12-18, and 20 depend from either claim 1 and 11, they too are allowable for at least the same reasons as the claim from which each depends. Further, these dependent claims each contain additional patentable subject matter. Therefore, the undersigned respectfully requests the Examiner to reconsider and withdraw the rejection under 35 U.S.C. §103 with regard to claims 1-8, 10-18, and 20.

Further, other than incentives related to potential price discounts, *Tavor* further fails to teach or suggest the additional claimed elements of dependent claims 4 and 14 reciting elements related to factors of the received information. *Tavor* does not discuss any type of factors related to an historical harm, a future harm, an incentive, a punishment, a request, an offer, and a desired

³ *Tavor* at Abstract.

⁴ *Office Action* at 3.

⁵ *D'Alessandro* at Abstract.

outcome. Instead, in the passages of *Tavor* to which the Examiner specifically referred,⁶ *Tavor* merely discusses comparing prices or offering discounts.

According to the present invention, there is provided a method for an automatic negotiation process with a user through an electronic interface for a product having a starting price and a price offer from the user, the steps of the method being performed by a data processor, the method comprising the steps of: (a) comparing the price offer to the starting price according to a negotiation comparator; (b) if the negotiation comparator is fulfilled by the price offer, accepting the price offer of the user; and (c) alternatively, if the negotiation comparator is not fulfilled by the price offer, offering a discount incentive to the user.⁷

Hereinafter, the term "discount incentive" refers to an incentive for a user to purchase a product, including but not limited to, a discount in the price of the product, a present (such as an additional product at a low cost or at no additional cost), a benefit (such as a "buyers club" card) and a discount in the price of shipping the product.⁸

Consequently, *Tavor* is completely silent on point. The undersigned has searched the entirety of *Tavor* and can find no hint, or even a suggestion of any type of factors related to an historical harm, a future harm, an incentive, a punishment, a request, an offer, and a desired outcome. Therefore, for at least these additional reasons, the undersigned requests the Examiner to reconsider and withdraw the rejection of claims 4 and 14 under 35 U.S.C. § 103(a).

Allowable Subject Matter

On page 2, paragraph 3 of the *Office Action*, the Examiner objected to claims 9 and 19 as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The undersigned thanks the Examiner for recognizing the novel and non-obvious nature of claims 9 and 19. However, as noted above, the undersigned has shown that claims 1-8, 10-18, and 20 are

⁶ See *Office Action* at 4.

⁷ *Tavor* at col. 2, lines 31-41.

⁸ *Id.* at col. 2, lines 56-61.

patentable. Therefore, the undersigned declines the opportunity to amend the claims to incorporate the limitations of claims 9 and 19 and the intervening claims.

CONCLUSION

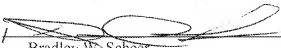
The undersigned respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone the undersigned attorney at (408) 660-2015 to facilitate prosecution of this application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.
P.O. Box 2938
Minneapolis, MN 55402-0938
(408) 660-2015

Date August 22, 2012

By /


Bradley W. Scheer
Reg. No. 47,059